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09/418,509 10/15/99 ROCHON

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EXAMINER

TM02/0124

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ART UNIT

PAPER NUMBER

2162

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/418,509

Applicant(s)

ROCHON ET AL.

Examiner

Jean D Janvier

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) 5 and 24 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: PTO-1472 & PTO-326.

1. DETAILED ACTION

2. Drawings

3. *In fig.2, there is some inconsistency with the labeling system. The label 202 can only be used once. Correction is required.*

4. Specification

5. *The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.*
6. *On page 5, "The computer network 200 of Fig. 2..", appears to be an improper reference. There is no label marked 200. Correction is required.*
7. *On page 11, "the central computer 204", cited twice, appears to be inconsistent. The central computer is 206. Correction is required.*
8. *On page 12, in " The designated product is identified uniquely identifiable typically by a UPC code" appears to be redundant. The Examiner suggests using " is uniquely identified" instead Correction is required.*
9. *On page 6, in " Step 1 illustrates a user 202" appears to be inconsistent. Step 1 does not show a user, but a "response to a banner or cookie". Again, the computer network 200 appears to be an improper reference. Corrections are required.*
10. *On page 15, in "Furthermore, identifying why the consumer did not by.", the word "by" should apparently be -- buy--. Correction is required.*

11. Claim Rejections - 35 USC § 112

12. Claims 4, 19, 22, 29, and 30 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention.

13. As per claim 22, line 1, " The system of claim 1, further comprises"

14. lacks clear antecedent basis. In fact, claim 1, on which claim 22 depends upon, refers to a method not a system. "System" should be changed to --Method--.

15. As per claims 29, line 1, " The method of claim 28 further comprises" lacks clear antecedent basis. In fact, claim 28, on which claims 29 depends upon, refers to a system not a method. "Method" should be changed to --System".

16. As per claims 30, line 1, " The method of claim 28 further comprises" lacks clear antecedent basis. In fact, claim 28, on which claims 30 depends upon, refers to a system not a method. "Method" should be changed to --System".

17. As per claims 4, " ---purchases said product" lacks clear antecedent basis. In fact, claim 1 makes reference to a sample of a product, not to the product itself.

18. As per claims 19, " ---purchases said product" lacks clear antecedent basis. In fact, claim 1 makes reference to a sample of a product, not to the product itself.

19. Claim Rejections - 35 USC § 102(e)

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

21. (e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
22. Claims 1, 2, 3, 5, 16, 18 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin David Hoyle, US Patent 6,141,010.
23. The applied reference, based upon its earlier effective U.S. filing date, constitutes a prior art under 35 U.S.C. 102(e).
24. As per claims 1, 2, 3, 5 and 18 Hoyle teaches a "Computer Interface Method And Apparatus with Targeted Advertising". Hoyle discloses, among other things, a method for supplying demographically targeted advertising to a computer user. This method includes the steps of:
25. Transmitting a signal, such as a banner advertising embedded in an application software that is downloaded over the internet to a network address (TCP/IP), that prompts a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer. This software application, which includes the banner ad, is accessible from a server or main computer via a computer network such as the internet and demographic information on the user is acquired by the main computer and used for determining what banner ad will be sent to the user (profiling the user). See abstract. Such banner ad constitutes a signal that is capable of prompting an end-user to visit a

particular web site (web page) where free product samples are being offered.

Furthermore, The use of a banner ad, cookie, or a scrolling text at the bottom of a viewing page to prompt a user to visit a site for information regarding free product samples, such as free software download, is inherent with internet surfing, especially if a user is receiving free internet access from ISPs such as Netzero, Lycos and Juno. These companies generate their income from banner ad. paid for by advertisers. When a user clicks on a particular banner ad, he will automatically be switched to the manufacturer's web site (URL) for more details.

26. Transmitting a manufacturer's sample offer from a server (main computer) over the computer network (internet) to a network address (IP address) for the user's computer if the user's profile data meets user profile criteria associated with a manufacturer's sample offer by selecting advertising contents (sample offer) from the main computer via the internet for transfer to the computer user (network address) in accordance with the demographic information associated with the unique identifier. Here, it is understood that demographic data (age, income, etc) is used as criteria to profile a user as to whether or not the said user is qualified to receive a product sample such as a free software download.

27. Generating instructions, which require an internet user to log on and visit an advertiser's site upon receiving a signal such as a banner ad prompting him to do so. Then the user, while surfing the advertiser's site, will make a request for a download. Upon receiving the request from the user, the manufacturer (advertiser) will send out a registration form to the user. The user receives the form and fills out

all required fields and instantly submits the form to the advertiser, which checks the form for accuracy. In the end, a unique identifier (ID) is assigned to the computer user which, along with the identifying information, is sent over the computer network (internet) from the network address, client or workstation, to the server or main computer associating the unique identifier with the demographic information (profile data) stored in a User/Demographics database (consumer database). See sheet 9 of 14, fig. 8 and sheet 3 of 14 and fig. 3. Once, the manufacturer receives the completed registration form and determines that user's demographic data have matched its criteria for sending a product sample offer to the said user, an e-mail could be sent to the user, which will provide information regarding the delivery of the sample offer. The user can send an e-mail to the advertiser as to indicate his acceptance of the offer. It is understood that the use of an e-mail as a communication means is widely used by companies doing business on/off the internet.

See column 5 of Hoyle.

Claims 16 and 31 contain limitations addressed in claim 1 and therefore, these limitations of claims 16 and 31 are rejected under a similar rationale. Claim 16 and 31 further recite a main computer and a computer program respectively with means of performing the steps outlined in claim 1. As per these features, Hoyle's computer systems include program instructions such as client software application, which is made of two modules (GUI Module and ADM Module). See sheet 1 of 14, fig. 1. Working

together, these two modules GUI (graphical user interface) and the ADM (Advertising Data Management) act as a single software that provides the computer user with a fully integrated interface to the other software and hardware loaded on the user's computer, as well as resources on the internet. In general, GUI contains basic programming instructions necessary to provide a user interface to the computer's software applications and operating system (e.g. Windows98 and WinNT) while the ADM module provides basic management as well as the acquisition and reporting of the user computer usage information to the ADM server (main computer) via the internet. Finally, all computer system mentioned herein, may be using Intel Pentium chips as processors. As it is known in the art, a common computer includes RAM, Hard Disk drive (means for storing), floppy drive, CD-ROM and DVD drives, mouse, keyboard, monitor, network card or a modem along with telephone lines for accessing the ADM server or main computer over the internet. See column 6 & 7, lines 65-85.

28. Claim Rejections - 35 USC § 103(a)

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
31. Claims 4, 6-10, 12-15, 19-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle.
32. As per claims 13, 20 and 28, Hoyle discloses in fig. 3 an ADM Server, main computer, with two databases namely an Ad Database and a User/Demographics Database. The demographic database (consumer database) contains, as mentioned herein, the user unique ID and profile data. However, Hoyle does not explicitly suggest using this demographic database, consumer database, to store purchase data regarding a user's purchase. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoyle's Demographic database as to store both user profile and purchase data thereby reducing the amount of computer hardware involved and at the same time helping the advertiser (manufacturer) to create an individual image of the user and hence determining if the

user's profile data and purchase data meet manufacturer's criteria for a free product sample. In the end, whether or not the user is qualified to receive the free product sample, the marketing department will be able to use this information to further target this end-user by periodically offering him some other incentives.

33. Moreover, Hoyle purposely discloses means such as a computer system or the ADM Server with, among other things, a Hard disk drive for storing the user profile and purchase data (see fig. 3).

34. As per claims 6, 7, 8, 12, 15, 21, 22, 23, 27 and 30, Hoyle's computer systems include program instructions such as client software application, which is made of two modules (GUI Module and ADM Module). See sheet 1 of 14, fig.1. Working together, these two modules GUI (graphical user interface) and the ADM (Advertising Data Management) act as a single software that provides the computer user with a fully integrated interface to the other software and hardware loaded on the user's computer, as well as resources on the internet. In general, GUI contains basic programming instructions necessary to provide a user interface to the computer's software applications and operating system (e.g. Windows98 and WinNT) while the ADM module provides basic management as well as the acquisition and reporting of the user computer usage information to the ADM server (main computer) via the internet. Finally, all computer system mentioned herein, may be using Intel Pentium chips as processors. . As is known in the art, a common computer includes RAM, Hard Disk drive (means for storing), floppy drive, CD-ROM

and DVD drives, mouse, keyboard, monitor, network card or a modem with telephone lines for accessing the ADM server or main computer over the internet.

See column 6 & 7, lines 65- 85 of Hoyle.

35. Since the client (user's computer) 40 and ADM Server (main computer) 22 are connected to the internet (computer network) 20 using either a modem or a network card as a communication means along with an operating system such as Win98 or WinNT and a browser such as Netscape or Internet Explorer, it would have been obvious to one of ordinary skill in the relevant art at the time of the invention to use Hoyle's system as described herein as to maintain communication between an advertiser (manufacturer) and a targeted user via e-mail. See figure 3. Additionally, using the above system, a manufacturer can very easily send an e-mail to a user not only to indicate to said user that he qualifies for a free product sample, but also to solicit a feedback from said user regarding said product sample. Once again, using Hoyle's system as mentioned above, the manufacturer can also send an e-mail asking the said user to provide once more his postal mailing address so that the product sample can be delivered directly to him if desired.

36. In fig. 3, Hoyle has disclosed, among other things, Ad servers 50. These Ad servers are connected to the internet (computer network) 20 using a modem as a communication means along with an operating system such as Win98 or WinNT and a browser such as Netscape or Internet Explorer, it would have been obvious to one of ordinary skill in the art at the time of the invention to use at least one Ad server as to exchange information regarding a targeted user between a third party's, clearing

house, system and the manufacturer's ADM Server (main computer) 22. By so doing, the manufacturer can very easily send a user's record over the internet to be processed by the third party. Further, the manufacturer could have sent the record to the third party by simply sending an e-mail to the third party whether or not said party has a server directly connected to the internet.

37. As per claims 4 and 19, Hoyle does not expressly show if the user has purchased a product, nor does he teach any means to determine if said user has purchased such a product? However, "Official Notice" is taken that it is commonly known in the art that product manufacturers usually require consumers to register any item purchased from a vendor using a registration form that is included inside in the packaging. This type of registration form contains fields such as name, home & work telephone numbers, e-mail address, home & work addresses, occupation, gender, age, product serial number, place & date of purchase and also the reason for buying the product. The more information that the user is required to provide, the better. For example, when a customer purchases a product such as a software application, Microsoft Office97, the customer is given the option, upon completion of the software installation into his computer system, to register the product electronically using his existing Fax/Modem. To do so, he must first fill out all required fields. Further, Registering a product with the manufacturer has a two-fold purpose- First of all, it allows the end-user (customer) to receive free technical support and free service or even a replacement if need be as long as the item is still under warranty. Second,

and most of all, it allows the manufacturer to create a customer's profile database, consumer database, with the information gathered via the registration form and use that information to further target the consumer by periodically offering some incentives to the said customer such as free product samples (free software download). Some manufacturers go so far as to sell this database to raise capitals. A great deal of manufacturers simply exchange customers' information among themselves. Finally, manufacturers can use the information contained in the registration form to ask the customer for feedback regarding a product that was purchased.

38. It would have been obvious, given the above disclosure, to one of ordinary skill in the art to use Hoyle's User/Demographics (consumer database) as to store the consumer's purchase data obtained from the registration form and thereby determining if said purchase data matches an original user's record (profile data) previously collected and stored in the consumer database during the free product sample offer registration conducted over the internet. If a match is found, then this customer has just purchased a product after he had tried a free sample (demo) of the said product.

39. As per claims 14 and 29, Hoyle does not explicitly disclose any consumer's conversion based at least in part on said purchase data stored in said consumer database as described above, nor does he teach any means for determining a consumer conversion? Nevertheless, it would have been obvious, given the

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information outlined above (see discussion on claims 4 and 19), to one of ordinary skill in the art to use Hoyle's User/Demographics (consumer database) as to store the consumer's purchase data obtained from the registration form and thereby determining if said purchase data matches an original user's record (profile data) previously collected and stored in the consumer database during the free product sample offer conducted over the internet. If a match is found, then this customer has just purchased a product after he had tried a free sample (demo) of the said product. Therefore, the manufacturer can knowingly determine that a consumer conversion has indeed taken place upon comparing the user profile data and purchase data stored in the consumer database (Demographic database).

40. As per claims 9, 10, 24 and 25, Hoyle does not expressly suggest mailing a coupon discounting a full price of said sample or a product sample to a postal mailing address to said user, nor does he disclose any means to mail such a coupon or sample? However, knowing the user's postal mailing address obtained via the online registration or by e-mailing the user requesting it, it would have been obvious to one of ordinary skill in the relevant art at the time of invention to use the user's postal mailing address in order to send a coupon discounting a full price of said sample at a participating store or a product sample directly to said user via a clearing house, US Postal Service, UPS, Federal Express or the like.

41. Claims 11, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle in view of Pruchnicki.

42. As per claims 11, 17 and 26, Hoyle does not explicitly disclose any means for determining (or even comparing) if user's profile data meets manufacturer's criteria for a free product sample, nor does he suggest transmitting an electronic coupon to a point of sale terminal for the full price of said sample in a transaction if a user involved in the said transaction had accepted the manufacturer's free product sample offer. However, Pruchnicki, US Patent 5,185,695, February 9, 1993, teaches a "METHOD AND SYSTEM FOR HANDLING DISCOUNT COUPONS BY USING CENTRALLY STORED MANUFACTURER COUPONS IN PLACE OF PAPER COUPONS". Pruchnicki discloses a method and apparatus for creating and processing discount coupons. This system comprises a central processor, manufacturer's computer, for receiving information, such as product type, validation period and coupon value, and producing a central coupon list of available coupon discounts. The central list is then transmitted to local processors, stores' computers, of participating retail establishments, which hold manufacturer products for sale. Here, the local processor produces a local coupon list based on the central list stored in the central computer. A coupon indicia is placed adjacent to the product type listed in the coupon list to identify a product as having a discount. When the product or item is brought by a customer to a checkout station, the manufacturer and product type are obtained off the product by a scanner and compared, using a coupon comparator, to the local coupon list. If the product is a coupon product, the

coupon value is obtained from the list and deducted from the retail price. A coupon counter then accumulates, by manufacturer and product type, the total coupon discounts redeemed. The central processor receives the information from the counter and directly bills the manufacturer or transfers funds to the retailer's bank account. The whole process is done electronically. In the end, no printed coupons are presented in order to obtain a discount.

43. It would have been obvious, given the above disclosure, to one of ordinary skill in the art at the time of the invention to incorporate Pruchnicki's teachings into Hoyle's system as to let a participating retail store use an Ad Server 50, a local processor, as to download coupon information including users' records and unique identifiers, stored in the User/Demographics or consumer database 46, from the ADM Server (main computer) 22, central processor, connected to the internet 20, computer network. Furthermore, Pruchnicki's coupon indicia could be used at a point of sale as to mark sample products with a special code thereby separating them from the products that the retail store has for sale. The user, upon providing his unique identifier to a sales clerk, during a transaction at a participating store, can pick up his sample product for free.

44. Moreover, it would have been obvious to one of ordinary skill in the relevant art to incorporate Pruchnicki's coupon comparator technique into Hoyle's system as to have a database program with two comparative fields, namely a Succeed Field and a Failure Field, which will allow a manufacturer to determine if a user profile data stored in the User database meets a manufacturer's criteria for a free product

sample. If a match is found, then the Succeed Field is updated and the user will receive a free product sample offer via e-mail.

45. Conclusion

46. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Reilly et al, US Patent 5,740,549, disclose an "Information And Advertising Distribution System And Method".
47. Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 8:30AM to 6:30PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. James P. Trammell, can be reached at (703) 305- 9768. His Fax number is (703) 305-0040.


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